

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

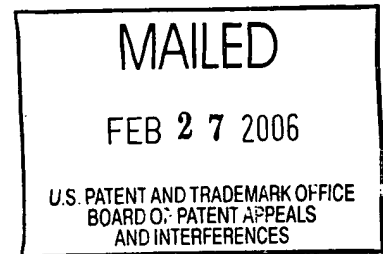
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOSEPH MCCOLLUM et. al.

Appeal No. 2005-1991
Application No. 09/589,647

ON BRIEF



Before KRASS, RUGGIERO, and MACDONALD, **Administrative Patent Judges..**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-26.

Invention

Appellants' invention relates to a system and method for allowing electronic health information (EHI) site on the Internet. The present invention allows insurance personnel to order patients' records and documents from a central online location (web site) or EHI site. The EHI then provides the insurance personnel an "authorization for release of records and documents" cover letter. The cover letter having an encoded barcode, along with a patient authorization letter, is submitted back to the EHI by the

insurance personnel. After an EHI employee has approved the patient's authorization, the EHI then sends the two letters to a health provider, clinic, hospital, etc., requesting it to send the patient's records and documents to a pre-selected facility. The insurance personnel can then retrieve the records and documents from this facility.

Appellants' specification at page 3, lines 15-23.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of obtaining a patient record or document using an online location on an electronic medium, comprising:

requesting an order, by a requestor, for the patient record or document from the online location;

providing to the requestor a cover letter having an identifier, the identifier having order information;

sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order;

requesting, by the processing center, to a shipping location to ship the patient record or document to destination location, and

obtaining, by the requestor, the patient record or document from the destination location.

References

The references relied on by the Examiner are as follows:

Eberhardt	5,659,741	Aug. 19, 1997
Edelson et al. (Edelson)	5,737,539	Apr. 7, 1998
Coli et al. (Coli)	6,018,713	Jan. 25, 2000

The reference relied on by this panel is as follows:

Powell et al. (Powell)	4,873,643	Oct. 10, 1989
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Rejections At Issue

Claims 1, 2, 4-10, and 12-26, stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Edelson and Eberhardt.

Claims 3 and 11 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Edelson, Eberhardt, and Coli.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-26 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new grounds of rejection of claims 1, 2, and 16. The basis for this is set forth in detail below.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

¹ Appellants filed an appeal brief on September 13, 2004. The Examiner mailed an Examiner's Answer on November 30, 2004.

I. Whether the Rejection of Claims 1-26 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-26. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by

which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 8 of the brief, "the only two portions of Edelson cited ... indisputably fail to disclose 'providing to the requestor a cover letter having an identifier, the identifier having order information,' as recited in claim 1." The Examiner responds at page 14 of the answer that based on Appellants' specification at page 11, "a 'cover letter' is nothing more than an authorization provided for completing an order or for releasing information." We find the Examiner's reading of Appellants' specification to be unjustified. Nothing in Appellants' specification warrants ignoring the physical nature of the "cover letter" itself. Nothing in the specification warrants reading the term "cover letter" to be taught by an "authorization" no matter what form it takes. Edelson fails to teach a letter as required by claim 1 (and independent claims 2 and 16).

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Rejection of Claims 1, 2, and 16 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 1, 2, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al (Powell) 4,873,643. We find that Powell teaches the following features:

1. The Powell reference as a whole inherently teaches obtaining (receiving) an ordered document.
2. Column 14, lines 16-18, and column 1, lines 55-60, teach a custom imprinted document in the form of a notebook cover, sign, bumper sticker, or business card.
3. Column 21, lines 23-27, and figures 1 and 11 teach obtaining the document using an online location (500) on an electronic medium (the communications line 175).
4. Column 19, line 66, through column 20, line 10, and column 22, lines 39-43, teach requesting an order from the online location.
5. Column 19, lines 66-67, and column 20, lines 1-2, teach providing a cover letter (order form) having order information (which may serve as an identifier).
6. Column 20, lines 7-10, teach sending the cover letter and a form of payment to a processing center.

Powell fails to explicitly teach requesting that the custom imprinted document is to be shipped after the manufacturing thereof at location 500. However, Powell explicitly teaches that on the order input side of the transaction there are two alternatives comprising interacting with a clerk (col. 20, line 6) and shipping (col. 20, line 9, "mailed"). An artisan would recognize that either alternative could also be used on the order output side of the transaction. Thus, the step of "requesting shipping" would have been obvious given the teachings in Powell.

Powell also fails to explicitly teach “a patient authorization letter.” However, as already noted, Powell sends a “form of payment” with the cover letter. Routine forms of payment include checks and other payment documents. Such documents are authorization letters that authorize fund transfers as a prerequisite to the transaction proceeding. We give no weight to the source (a patient) of the authorization letter, as it does not change the subsequent process of authorizing the transaction based on the authorization letter. Thus, the step of “sending an authorization letter” would have been obvious given the teachings in Powell.

Also, both the Examiner and Appellants should note that even if the claims were limited to “a patient record” rather than the broader claimed alternative “document,” the claims would be obvious over Powell. Powell does not teach nonfunctional descriptive material in the form of the information in the document being a patient record. However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. **In re Ngai**, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. **In re Gulack**, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Therefore, we reject claims 1, 2, and 16, under 35 U.S.C. 103(a) as being obvious over Powell.

Other Issues

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 CFR § 41.50(b). However, we have not reviewed claims 3-15 and 17-26 to the extent necessary to determine whether these claims are patentable over the Powell patent. We leave it to the instant Examiner to determine the appropriateness of any further rejections based on these references.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-26.

We have entered a new grounds of rejection against claims 1, 2, and 16 under 37 CFR § 41.50(b).

As indicated *supra*, this decision contains a new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004).

37 CFR § 41.50(b) provides that, "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:



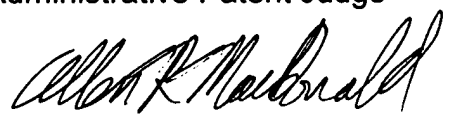
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(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record ...

REVERSED

37 CFR § 41.50(b)

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ERROL A. KRASS)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	
)	APPEALS AND
)	
ALLEN R. MACDONALD)	INTERFERENCES
Administrative Patent Judge)	

ARM/gw

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